

### **REMARKS**

Applicants thank the Examiner for his courtesy during the June 6, 2005 telephone call with Applicants' representative, Michael Rodriguez.

Claims 1-3, 5-14, 17-22, 24-33, 36-41, 43-54, and 57-59 were presented for examination. The Office Action dated March 2, 2005 rejects all of these claims. Claims 1-3, 5-14, 17-22, 24-33, 36-41, 43-54, and 57-59 remain pending in the application.

The Office Action rejects claims 1-2, 5, 7-10, 13, 17, 20-21, 24, 26-29, 32, 36, 39-40, 45-48, 53 and 57 under 35 U.S.C. 103(a) as being obvious over Hsu (U.S. Patent No. 6,363,319) in view of Bertin (U.S. Patent No. 5,940,372). The Office Action also rejects claims 3, 6, 14, 22, 25, 33, 41, 43-44, and 54 under 35 U.S.C. 103(a) as being obvious over Hsu in view of Bertin, and further in view of Roginsky (U.S. Patent No. 6,034,946), and rejects claims 11-12, 18-19, 30-31, 37-38, 49, 50-52, 58, and 59 under 35 U.S.C. 103(a) as being obvious over Hsu in view of Bertin, and further in view of Bertin (U.S. Patent No. 5,687,167).

Applicants respectfully traverse the rejections because Hsu is disqualified as prior art against the Applicants' claimed invention under 35 U.S.C. 103(c)(1). According to 35 U.S.C. 103(c)(1), "subject matter developed

by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The Hsu patent was filed on August 31, 1999, less than one year before the August 24, 2000 filing date of the Applicants’ application, and issued March 26, 2002. Applicants submit that the Hsu patent qualifies as prior art only under subsection 102(e).

Further, the Applicants’ patent application (No. 09/645,186) and the Hsu patent were, at the time the invention of Application No. 09/645,186 was made, owned by or subject to an obligation of assignment to Nortel Networks Limited (formerly Nortel Networks Corporation). In support of this statement, the Applicants present the following:

First, the Hsu patent was assigned to Nortel Networks Corporation on August 30, 1999 and later to Nortel Networks Limited on August 30, 2000 by virtue of a name change of the corporation. A copy of a Patent Assignment Abstract of Title for the Hsu patent is enclosed herewith.

Second, at the time of the Applicants made the invention, the Applicants’ claimed invention was subject to an obligation of assignment to

Nortel Networks Limited. The Applicants' application was filed on August 24, 2000 and the Applicants executed an assignment to Nortel Networks Limited of the Applicants' application on December 19, 2000 and on January 11, 2001. The assignment was recorded on January 22, 2001 at reel/frame 011463/0127. A copy of the Assignment Recordation is enclosed herewith.

In view of Hsu being disqualified as prior art, Applicants respectfully submit that any rejection of the Applicants' claims based on Hsu in view of Bertin ('372), Roginsky, Bertin ('167), or any combination thereof is rendered moot. Applicants therefore respectfully request that the rejections of the claims be withdrawn. Notwithstanding, should the Examiner determine that Hsu is in fact valid prior art for purposes of 103(a), Applicants' respectfully request that the Examiner issue a non-final action (rather than a final), if this is within the Examiner's discretion.

### **CONCLUSION**

In view of the arguments made herein, Applicants submit that the application is in condition for allowance and requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the Applicant's representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-2003.

Authorization is hereby granted to apply any credits or fees due in this case not covered by check to Deposit Account 50-2295.

Respectfully submitted,

Date: 6/7/05  
Reg. No. 41,274

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RECORDATION DATE: 01/22/2001

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BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

FEDYK, DONALD

DOC DATE: 12/19/2000

ASSIGNOR:

ASHWOOD-SMITH, PETER

DOC DATE: 01/11/2001

ASSIGNOR:

JAMOUSSE, BILEL

DOC DATE: 12/19/2000

ASSIGNEE:

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SERIAL NUMBER: 09645186

PATENT NUMBER:

FILING DATE: 08/24/2000

ISSUE DATE:

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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

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## Total Assignments: 2

Patent #: 6363319 Issue Dt: 03/26/2002 Application #: 09387036 Filing Dt: 08/31/1999

Inventor: IVY P. HSU

Title: CONSTRAINT-BASED ROUTE SELECTION USING BIASED COST

## Assignment: 1

Reel/Frame: 010228/0069

Recorded: 08/31/1999

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: HSU, IVY P.

Exec Dt: 08/30/1999

Assignee: NORTEL NETWORKS CORPORATIONWORLD TRADE CENTER OF MONTREAL, 380 ST. ANTOINE STREET WEST, 8TH  
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## Assignment: 2

Reel/Frame: 011195/0706

Recorded: 08/30/2000

Pages: 251

Conveyance: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS).

Assignor: NORTEL NETWORKS CORPORATION

Exec Dt: 08/30/2000

Assignee: NORTEL NETWORKS LIMITEDWORLD TRADE CENTER OF MONTREAL  
380 ST. ANTOINE STREET WEST, 8TH FLOOR  
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